

RESPONSE AND REMARKS

ALLOWABLE SUBJECT MATTER

In the Office Action, Claims 1-3 were designated as allowable subject matter.

The designation of Claims 1-3 as allowable subject matter is gratefully acknowledged with appreciation.

It is respectfully submitted that dependent Claim 29 is dependent on Claim 2, which was designated as allowable. It is therefore respectfully submitted, and hereby requested, that dependent Claim 29 also be designated as allowable.

REJECTIONS UNDER SECTION 101

In the Office Action, Claims 7, 13, 19-22 and 33 were rejected under 35 U.S.C. §101 on grounds that the claimed invention is directed to non-statutory subject matter. Office Action, Topic No. 12, pages 5-7.

RESPONSE REMARKS TO REJECTIONS UNDER SECTION 101

The rejections under Section 101 have been carefully considered. Independent Claims 7 and 13, and dependent Claims 4-5, 7, 13, 19-22, 31, and 33, have been amended to more distinctly claim the claimed invention. It is respectfully asserted that the amendments to the Claims, resolve the rejections under Section 101. In particular, Claims 7 and 13, as amended, claim using a computer to generate postage indicia and other indicia, and to facilitate printing of the indicia on labels. It is respectfully asserted that amended Claims 7 and 13, and therefore the claims that are dependent on them, , recite patentable subject matter under Section 101.

REJECTION UNDER SECTION 103(a)

In the Office Action, Claims 4-6, 13, 19-21 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block (U.S. Patent No. 6,010,156, "Block") in view of Reid et al (U.S. Pub No. 2005/0195214 "Reid"). Office Action, Topic No. 14, pages 7-18.

In the Office Action, Claims 7, 22, 29, 30, 32 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Reid, and further in view of Pickering Jr. et al. (U.S. Patent No. 6,557,755; "Pickering"). Office Action, Topic No. 15, pages 18-30.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 103(a)

The rejections of Claims 4-7, 13, 19-22 and 30-33 under Section 103(a) have been carefully considered. Claims 8-12, 14-18, and 23-28 were previously cancelled; Independent Claims 7 and 13, and dependent Claims 4-5, 7, 13, 19-22, 31, and 33, of the present application are amended herewith to more distinctly claim the claimed invention; new independent Claims 34 and 35 have been added.

It is respectfully asserted that independent Claims 4, 5, and 7, as amended, and new independent Claim 34, claim dimensional and layout limitations indicated by the Office Action with reference to allowable Claims 1-3 as being distinguished from the cited references. It is therefore respectfully asserted that independent Claims 4, 5, 7, and 34, and the Claims that are dependent on them, namely Claims 6, 21-22, and 30-32, are therefore in condition for allowance.

Further, amended independent Claims 7 and 13, and new Claim 35, recite limitations more distinctly claiming that the orientation of the claimed barcode, or graphic symbology, is in a one-hundred-eighty degree rotation with respect to the orientation of the claimed postage indicia. It is respectfully asserted for the reasons explained further below, that the cited references do not disclose the limitations by amended independent Claims 7 and 13 and new Claim 35 for such a one-hundred-eighty degree rotation of a printing of a barcode, or graphic symbology, with respect to a printing orientation of postage indicia on labels of a label set

Further, for reasons similar to those previously given in response to the previous Office Actions for this case (which are incorporated herein), and for the reasons described further below, it is respectfully asserted that the pending Claims of the present application, as amended, are patentable over the cited references and are in condition for allowance.

NONE OF THE CITED REFERENCES DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS COMPRISING A POSTAGE INDICIA LABEL AND A SEPARATE LABEL DEDICATED FOR RECEIVING A BARCODE WITH THE CLAIMED DIMENSIONAL AND LAYOUT LIMITATIONS

It is not disputed that various cited references disclose printing a one-dimensional barcode. However, it is respectfully asserted that none of the references of record disclose or contemplate label sets comprising separate barcode labels with the dimensional and layout limitations as claimed, for example, in Claims 4-6, 30-32 and 34, or methods for printing barcodes on separate barcode labels, with the dimensional and layout limitations as claimed in one way or another by Claims 7, and 21-22 of the present application.

As compared to a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated ("consisting of") to receiving a printing of a single barcode as claimed in one way or another by, for example, Claims 4 and 5, it is respectfully submitted that none of the labels in *Block* are dedicated (for receiving printing "consisting of") to a barcode. Rather, it is respectfully submitted that each *Block* label that depicts a barcode, also depicts other types of information on the same label. See, e.g., FIG. 3A of *Block* (showing label 303 comprising address information 313 and a barcode 315; and showing label 305 comprising human-readable postage indicia 317 and two barcodes 321 and 319).

The Office Action cites *Block*'s disclosure that "[a]dditional labels within each field to be associated with a single item to be mailed may be added to accommodate a user's need. Each label within the field may also be customized and sized to accommodate the desired use, and various strips with variously formatted layouts may be made commercially available." E.g., *Office Action*, Topic No. 15 ("Referring to claim 7"), p. 19 (citing *Block*, col. 3, lines 33-36). The Office Action concludes "[t]herefore, one having ordinary skill in the art would have recognized that it would have been obvious for Block to have individual labels consisting only of a first one-dimensional barcode ... to maximize the convenience and utility to the end user." *Id.*

However, for the reasons given further below, the above-mentioned assertions by the Office Action with respect to what would be obvious in view of *Block* are respectfully traversed. In particular, it is respectfully submitted that *Block* expressly

states that “[e]ach field would include at least a label for the recipient’s address and a label for a postal service approved indicia, to be applied to the item to be mailed.” Block, col. 2, lines 17-21. Further, Block indicates that additional labels would comprise such other types of labels such as “return address or postal handling instruction labels ...” (Id.), but mandates that “[a] minimum of two label segments are required in each field ... to accommodate the intended recipient’s address and a postal service approved postage indicia” Block, col. 3, lines 12-15. See also, Block, col. 4, line 66 – col. 5, line 1 (“Each label, except the recipient address and postage indicia labels, is an optional element of the present invention.”).

Moreover, it is respectfully asserted that Block indicates that the Block-disclosed barcode (element 315 in FIG. 3A), is a standard part of, not separable from, the Block recipient address label. See, e.g., Block, col. 5, lines 6-9. It is therefore respectfully asserted that Block’s inclusion of a barcode on a label that includes other elements, combined with Block’s mandate for a recipient address label, in conjunction with Block’s treatment of a barcode as a standard part of a recipient address label, teaches away from a separate barcode label.

Therefore, it is respectfully asserted that there is no indication in Block that the Block-disclosed barcode (element 315 in FIG. 3A), is separable from the Block recipient address label. Accordingly, it is respectfully asserted that Block, even when considered in combination with the other cited references, does not disclose, anticipate, teach or suggest, a separate barcode label for printing only a barcode, or methods for printing such a separate barcode label, as claimed by the rejected Claims, and that such a separate barcode label is therefore not obvious in view of Block.

In view of the above-given reasons, it is therefore respectfully asserted that as compared to the claimed limitations of, for example, Claims 4 and 5 in which a one-dimensional barcode label is claimed to comprise a set of dimensions adapted to be printed with a printing *consisting* of a one-dimensional barcode, even though Block discloses a barcode (element 315) that is printed on an address label (element 303), Block does not disclose separately printing a barcode on a separate or distinct barcode label, and doing so is not obvious in view of Block, even when that reference is combined with the other cited references.

In support of the rejections, the Office Action cites Pickering as disclosing “separate one-dimensional barcodes ... (Fig 1; col 1: lines 45-55).” *E.g.*, Office Action, Topic No. 15, p. 19 (“Referring to Claim 7”). However, it is respectfully asserted, for the following reasons, that the limitations recited by, for example, independent Claim 7, are patentably distinct from Pickering, even when that reference is considered in combination with Block.

In particular, it is respectfully submitted that although Pickering discloses printing one-dimensional barcodes (depicted as elements 202 and 204 in Pickering's FIG. 2), Pickering discloses doing so directly on an address block (designated as element 200 in Pickering's FIG. 2) of a mail piece. See Pickering, col. 3, lines 37-38. Further, Pickering explains that “[s]uch an address block can either be printed on the outside of an envelope or on a mailpiece inserted in an envelope such that address block 200 is visible through a window in the envelope.” Pickering, col. 3, lines 38-42.

In view of the above-identified disclosures of Pickering, it is therefore respectfully asserted that Pickering does not disclose printing only a subset of elements to be applied to a mail piece, such as postage indicia and a one-dimensional barcode, but not a recipient address, on a label arrangement set.

As distinguished from the disclosure of Pickering of printing one-dimensional barcodes directly on a mail piece, the Claims of the present application claim, for example, label sets comprising a barcode label that is adapted to be printed with a printing consisting of a one-dimensional barcode. See, *e.g.*, Claim 7.

Moreover, it is respectfully asserted that self-adhesive label sets comprising separate barcode labels, or separately printing a barcode on a separate barcode label of a label set, or methods for printing barcodes on separate barcode labels, as claimed in one way or another by Claims 4-7, 21-22, 30-32 and 34, would be useful over the cited references, in that such separate barcode labels and the claimed postage indicia label could be applied to envelopes on which delivery and/or return address information had been previously printed, or to envelopes with windows through which delivery and return address information is displayed. See, *e.g.*, FIGS. 12-18 of the present application depicting self-adhesive label sets comprising a postage indicia label and at

least one separate barcode label that are adapted for affixing separately to mail pieces on which or through which delivery address information is otherwise provided.

Yet further, as with Claims 1-3 and 29, identified by the Office Action as allowable, Claims 4-6 and 34 (and their respective dependent Claims) claim limitations regarding dimension and layout that are distinguished from the cited references. For example, amended Claim 4 claims:

... the first one-dimensional barcode label comprising a label length and a label height, the one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the label length exceeding the one-dimensional barcode length and the label height exceeding the one-dimensional barcode height, the label height being less than the postage indicia label height, the label height being less than the postage indicia label length, the label length being greater than the postage indicia label height, and the label length being greater than the postage indicia label length

For the above-given reasons, it is respectfully asserted that the limitations claimed by, for example, Claims 4-6 and 34 (and their respective dependent Claims), regarding a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is adapted to being printed with a printing consisting of a single barcode, with the claimed label dimensional and layout limitations, and methods for printing such labels, such as claimed in Claim 7 (and its respective dependent Claims), are distinguished from the cited references. Accordingly, it is respectfully asserted that Claims 4-7, 21-22, 30-32 and 34, are therefore patentable over the cited references and are in condition for allowance.

NONE OF THE REFERENCES OF RECORD DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS WHERE EACH SET COMPRISES A COMBINATION OF PORTRAIT-ORIENTED LABELS ADAPTED FOR RECEIVING PORTRAIT-ORIENTED PRINTING OF POSTAGE INDICIA AND LANDSCAPE-ORIENTED LABELS ADAPTED FOR BEING PRINTED WITH A LANDSCAPE-ORIENTED PRINTING OF BARCODE LABELS IN A ONE-HUNDRED-EIGHTY DEGREE ROTATION WITH RESPECT TO THE PORTRAIT-ORIENTED POSTAGE INDICIA LABELS, OR METHODS FOR SO PRINTING SUCH LABELS

The Office Action concedes that "Block does not expressly disclose the sheet of a plurality of computer printer printable self-adhesive label sets ..., wherein the first label is disposed in a portrait orientation with respect to the sheet, and wherein the

barcode label is disposed in a landscape orientation with respect to the sheet.” Office Action, Topic “Referring to claim 6,” p. 8.

However, the Office Action asserts that “Reid et al disclose printing on one sheet pictures in both portrait and landscape orientation.” Office Action, Topic “Referring to claim 6,” p. 8 (citing FIG. 8e and paragraphs [0084] and [0089] of Reid).

The rejections and the reasons for the rejections have been carefully considered. Claims 7, 13, 19-22, and 33 have been amended, and new Claim 35 has been added, more distinctly claiming the claimed invention. For the reasons described further below, it is respectfully asserted that none of the cited references, whether considered alone or in combination, disclose, anticipate, teach or suggest printing postage indicia in a first orientation, and printing a barcode or graphic symbology in a one-hundred-eighty degree rotation with respect to the orientation of the postage indicia, as claimed in one way or another by amended Claims 7, 13, 19-22, and 33, and new Claim 35.

The Office Action cites FIG. 8e of Reid as disclosing printing pictures in both portrait and landscape orientation.

FIG. 8e of Reid depicts both a portrait-oriented rectangle and a landscape-oriented rectangle on a single page.

It is respectfully asserted that, as a published application, it would only be proper to use Reid as a prior art reference “... for what is in fact disclosed in it.” Cf. Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art).

It is respectfully asserted that even though Reid discloses two differently shaped rectangles on a single page (see, Reid, FIG. 8e), Reid does not expressly disclose printing an image in portrait orientation on one of the depicted rectangles, and then printing on the other depicted rectangle on the same page, a landscape-oriented image in a one-hundred-eighty degree rotation with respect to the portrait-oriented image. Rather, it is respectfully submitted that Reid is directed to creating “an aesthetically pleasing photobook.” Reid, ¶ [0080]. It is respectfully asserted that, in view of the disclosure of Reid for creating “an aesthetically pleasing photobook” (Reid, ¶ [0080]), even though FIG. 8e depicts two differently shaped rectangles, it is respectfully asserted

that the photobook page of Reid depicted in FIG. 8e, would be viewed from a single “aesthetically pleasing” perspective, such as the view depicted in FIG. 8e. Therefore, it is respectfully asserted that any images printed respectively in the two differently shaped rectangles depicted in the photobook page of Reid’s FIG. 8e would both be printed with, and viewed from, a single “aesthetically pleasing” orientation, such as the perspective depicted in FIG. 8e.

As compared to a single view of a photobook page as depicted in Reid, it is respectfully asserted that independent Claims 7 and 13, as amended, and new Claim 35, claim a one-hundred-eighty degree rotation of the format of a barcode, or graphic symbology, with respect to an orientation of postage indicia. That is, in order to view the postage indicia, a viewer would hold the respective sheet in one direction; in order to view the barcode or graphic symbology, the viewer would need to rotate the sheet one-hundred-eighty degrees. It is respectfully submitted that the one-hundred-eighty degree rotation is supported by the Specification. See, e.g., FIG. 16 of the present application.

Further, it is respectfully asserted that printing on label sets on a sheet of self-adhesive label stock, postage indicia in one orientation and a barcode or graphic symbology in a one-hundred-eighty degree rotation orientation with respect to the postage indicia as claimed by Claims 7 and 13, and with the claimed label dimensional and layout limitations of Claim 7, is distinguished from information printed directly on a mail piece as disclosed by Pickering.

In particular, it is respectfully asserted that the one-dimensional barcodes, depicted as elements 202 and 204 in Pickering’s FIG. 2, are depicted as being printed in the same orientation as the recipient’s address. It is therefore respectfully asserted that Pickering does not disclose printing one-dimensional barcodes in a different orientation from the orientation of the recipient’s address, or postage indicia.

In view of the features of Pickering described above, it is therefore respectfully asserted that combining the disclosure of Pickering for printing one-dimensional barcodes on the same mail piece in close proximity with, and in the same orientation as, a recipient address, even when combined with Block’s required recipient address label that includes a barcode, does not disclose, anticipate, teach or suggest methods for

printing postage indicia and one or more separate barcode labels on sheets of label sets, such that the barcode/graphic symbology is oriented for printing in a one-hundred-eighty degree rotation with respect to the postage indicia as claimed in one way or another by amended Claims 7, 13, 19-22, 33 and 35 of the present application.


In view of the above-described distinctions, it is respectfully asserted that the cited references, even when considered together, fail to disclose the combination of limitations claimed by amended Claims 7 and 13, and new Claim 35, and therefore the Claims dependent on them, namely Claims 19-22, and 33, of the present application. Accordingly, it is respectfully asserted that Claims 7, 13, 19-22, 33, and 35 are therefore patentable over the references of record and are in condition for allowance.

CONCLUSION

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By 
Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856